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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/027,439	02/20/1998	FRANKLIN H. PORTUGAL	044198.0000	3103

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12/24/2003

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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/027,439

Applicant(s)

PORTUGAL ET AL.

Examiner

Jehanne Souaya Sitton

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 01 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☒ Newly proposed or amended claim(s) 47,48 and 54 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 52.

Claim(s) objected to: 58.

Claim(s) rejected: 47,48 and 53-58.

Claim(s) withdrawn from consideration: 21-36.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Jehanne Souaya Sitton
Primary Examiner
Jehanne Sitton

12/15/03

Continuation of 2. NOTE:

The proposed claim amendments raise new issues requiring further search and consideration under 35 USC 102 and 35 USC 103. It is noted that the rejection of claims 55 and 56 under 35 USC 102(a) and 102(e) as being anticipated by Hogan would be maintained with regard to newly proposed claims 55 and 56. Sequences A and B of Hogan are each 30 and 39 base pairs, respectively. As these sequences are completely complementary to portions of SEQ ID NOS 3, 5 and 6 as set forth in the previous office action (dated 5/1/2003) these sequences would be expected to hybridize to species of *Shigella* as set forth in the claims. The recitation of "targets" has not been interpreted to limit the claimed sequences to ones that will only hybridize to a specific species of *Shigella* and not to other sequences. In other words, such recitation does not structurally distinguish the claimed probes from the sequences taught by Hogan. With regard to the rejection of claim 55 under 35 USC 102(a) as set forth in section 10 of the previous office action, such would be maintained with regard to newly proposed claim 55 because claim 55 encompass sequences longer than 40 nucleotides in length. The length limitation of newly proposed claim 55 is with regard to sequences from SEQ ID NO: 3, however the comprising language in the claim encompasses a nucleic acid molecule that comprises a fragment of 11-40 nucleotides of a sequence of SEQ ID NO: 3. Such is taught by the Accession numbers recited in the rejection because the accession numbers teach nucleic acids that comprise a fragment with the minimum required contiguous sequences identical to a nucleotide sequence of SEQ ID NO: 3. Likewise, the rejection of claim 55 under 35 USC 103(a) as set forth in section 13 of the previous office action would be maintained with regard to newly proposed claim 55 for the same reasons.

Since the proposed amendment has not been entered, all claims except claim 52 stand objected and/or rejected as set forth in the previous office action.

If newly amended claims 47, 48 and 54 were presented in a separate timely filed amendment, canceling nonallowable claims, such claim would be allowable along with claim 52 which has already been indicated as allowable. Further, if claim 53 were also presented as newly amended and with the further amendment of changing the recitation of "a" nucleotide sequence to "the" nucleotide sequence (line 1 of claim 53) as in newly amended claim 54, such claim would also be allowable.

The proposed amendment would overcome the objection to claim 58 as well as the objection made to the specification, and the claim rejections made under 35 USC 101 (claims 55-58), 112/2nd paragraph (claims 55-58), and 102(b) (claim 54).

As the appeal brief filed 03 November 2003 was found defective, a notice with regard to such is set forth concurrently with this advisory action.